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SCHWEGMAN, LUNDBERG & WOESSNER/OPEN TV P.O. BOX 2938 MINNEAPOLIS, MN 55402-0938				
			EXAMINER	
			MCCULLOCH JR, WILLIAM H	
			ART UNIT	PAPER NUMBER
			3714	
			NOTIFICATION DATE	DELIVERY MODE
			10/01/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 09/939,306	<b>Applicant(s)</b> LEMMONS ET AL.
	<b>Examiner</b> William H. McCulloch	<b>Art Unit</b> 3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

#### Status

- 1) Responsive to communication(s) filed on 23 August 2010.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-8,17-38,44 and 51-59 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 17-38,44 and 51-59 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SAC-84) \_\_\_\_\_  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date: \_\_\_\_\_
- 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/23/2010 has been entered. Claims 1-8, 17-38, 44, and 51-59 are pending in the application, with claims 1-8 withdrawn from prosecution, claims 39-43 now cancelled, and claims 55-59 newly added. It is noted that claims 56-59 contain underlining that would indicate a claim amendment; however, it is reasonably clear that these claims are newly added and the Examiner will interpret them as such for purposes of this action.

### ***Notice of Invocation of 35 USC 112, sixth paragraph***

2. Applicant is hereby notified that claim 55 (and claims dependent thereon) recites "means for" language as defined in 35 U.S.C. 112, sixth paragraph.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 17, 19-32, 34-38, and 55-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over W.O. 99/00163 to Eilat et al. (hereinafter Eilat).

Eilat et al. discloses an interactive game system played over a network between at least two players over a television broadcast. In addition to the players viewing the broadcast, non-player viewers can view the broadcast as well.

Regarding Claims 17, 27, 30, and 55-56: Eilat et al. additionally discloses:

- a. launching an interactive game on a video game server communicatively coupled to said television broadcast system that controls play of said interactive game (Abstract, page 5, line 9-page 6, line 11, and page 7, line 7-page 8, line 18),
- b. generating first gaming code for embedding in a video broadcast stream, said first gaming code generated by said video game server for broadcast to a first set top box (14) at a specific address (player's set top box) in said video broadcast system, said first gaming code comprising a user interface for a first player of said at least two players (Page 6, line 21-page 7, line 7, page 13, lines 4-11, page 24, line 8-page 25, line 4, and figures 1-3);
- c. generating second gaming code for embedding in a video broadcast stream, said second gaming code generated by said video game server for broadcast to a second set top box (14) at another specific address (player's set top box) in said video broadcast system, said second gaming code comprising a user interface for a second player of said at least two players (Page 6, line 21-page 7, line 7, page 13, lines 4-11, page 24, line 8-page 25, line 4, and figures 1-3);
- d. receiving at said video game server a game control signal that is generated in response to an input from said first player playing said interactive game, and

message data from said first set top box (Page 7, lines 18-27 and page 9, line 8-page 10, line 4);

e. generating video images in said video game server in response to said signal (Page 7, lines 18-27 and page 9, line 8-page 10, line 4), for broadcasting a view of the game where the view of the game can be customized for the game played and for the at least two players (Page 22, line 24-page 23, line 3);

f. transmitting said video images for insertion into said video broadcast stream (Page 7, lines 18-27 and page 9, line 8-page 10, line 4);

g. said message data is transferred from said video game server to said second set top box (Page 23, lines 7-13); and

h. said video broadcast stream is broadcast to a plurality of set top boxes including set top boxes of said at least two players and said at least one non-participating viewer (Page 22, line 24-page 23, line 3).

Regarding claims 20 and 29: Eilat discloses combining said video images (first player character-avatar) with second video images (second player character-avatar) and broadcasting combined images to said plurality of set top boxes including said at least one set top box associated with a non-participating viewer (Page 7, lines 18-27, page 9, line 8-page 10, line 4, and page 22, line 24-page 23, line 3).

Regarding claim 21: Eilat discloses transmitting said game control signal to said second player (Page 7, lines 18-27, page 9, line 8-page 10, line 4, and page 22, line 24-page 23, line 3).

Regarding claim 22: Eilat discloses altering the display produced by said second set top box in response to said game control signal (Page 7, lines 18-27 and page 9, line 8-page 10, line 4).

Regarding claim 23: Eilat discloses generating video images that are an overview (outer view) of said interactive video game (Page 24, lines 8-26). A non-player may see the game from an "outer view", that is, to include a view of an outside viewer that watches the player as well as the environment in which the player acts.

Regarding Claims 26, 38, and 59: Eilat discloses that said interactive game is a game show game (Page 20, lines 4-9).

Regarding Claim 31: Eilat discloses that said network comprises a back-channel (network connection for communicating player control inputs) in said broadcast system (Page 7, lines 18-27 and page 9, line 8-page 10, line 4).

Regarding Claim 32: Eilat discloses that said network comprises a connection to the Internet (Page 14, lines 14-24).

Regarding Claim 34: Eilat discloses code that produces a first graphical image of said game in said first set top box (Page 20, lines 10-18). The game show allows the combination of the face of the viewer with the avatar to be made in set top box (14), in which case it would be possible for different viewers in addition to the players to each combine their face with the player's avatar such that each viewer/player would have a unique view on the display.

Regarding Claim 35: Eilat discloses code that produces a second graphical image that differs from said first graphical image of said game in said second set top

box (Page 20, lines 10-18). The game show allows the combination of the face of the viewer with the avatar may be made in set top box (14), in which case it would be possible for different viewers in addition to the players to each combine their face with the player's avatar such that each viewer/player would have a unique view on the display.

Eilat et al. lacks explicitly disclosing:

Regarding Claims 17, and 27: embedding first markup language code in a video broadcast stream; and embedding second markup language code in said video broadcast stream.

Regarding Claims 19 and 28: embedding HTML code in said video broadcast stream.

Regarding Claims 24, 36, and 57: said interactive game is a sports game.

Regarding Claims 25, 37, and 58: said interactive game is a casino game.

Regarding claims 17, 19, 27, and 28: Eilat discloses embedding first and second gaming code in a video broadcast stream. Furthermore, Eilat et al. discloses the video broadcast stream can be communicated over the Internet using Internet protocols. Embedding HTML (hypertext markup language) in a broadcast stream over a network, such as the Internet, was notoriously well known at the time of Applicant's invention. Embedding HTML signals in the broadcast enables the players gaming machine, set top box, and television to incorporate text, graphics, sound, and video associated with the game.

Regarding Claims 24, 25, 36, 37, 57, and 58, Eilat et al. discloses the interactive game is a game between a first and second player competing against each other (Page 8, lines 8-18). It would have been obvious to one having ordinary skill in the art at the time of Applicant's invention to implement well-known sports or casino games in Eilat. One would be motivated to do so because interactive sports and casino games are entertaining to game players.

5. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eilat in view of U.S. 6,335,744 to Korilis et al. (hereinafter Korilis).

Eilat teaches to one having ordinary skill in the art the features discussed above regarding claims 17, 19-32, 34-38, and 55-58. Regarding claim 44, Eilat seems to lack explicitly disclosing "wherein the registration of at least one of the first and second players is solicited through an advertisement." Korilis, like Eilat, teaches conducting games over a communication network. Therefore, Korilis and Eilat are analogous art. Korilis teaches a game designed to lure computer users (players) to different websites to play a game. Korilis teaches "wherein the registration of at least one of the first and second players is solicited through a television advertisement" (Column 1, lines 18-32, column 2, lines 32-45, and column 3, line 61-column 4, line 16). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate Korilis' registration feature in Eilat. The motivation to do so is because a player would be entertained playing the game and would be more likely to purchase a company's product by viewing the advertisement on the associated web site.

6. Claims 18 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eilat in view of *Creating a live Broadcast from a Virtual Environment*, Computer Graphics Proceedings, Annual Conference Series, by Greenhalgh et al. (hereinafter Greenhalgh).

Eilat teaches to one having ordinary skill in the art the features discussed above regarding claims 17, 19-32, 34-38, and 55-58. Regarding claims 18 and 33, Eilat seems to lack explicitly disclosing "displaying player controls in a first portion of a screen viewed by said first player and said video images in a second portion of said screen using said first markup language code." Greenhalgh teaches an interactive game presented to conventional passive viewers (television broadcast audience) and to online participants (game players). Therefore, Greenhalgh and Eilat are analogous art. Furthermore, Greenhalgh teaches "displaying player controls in a first portion of a screen viewed by said first player and said video images in a second portion of said screen using said first markup language code" (Figure 9 and page 380). It would have been obvious at the time of Applicant's invention to incorporate Greenhalgh's flying vehicle controls and video output in Eilat. One would be motivated to do so because this would enable a player lacking Eilat's "virtual reality kit" to generate player inputs to the game via a conventional personal computer mouse.

7. Claims 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eilat in view of U.S. 6,758,754 to Lavanchy et al. (hereinafter Lavanchy).

Eilat teaches to one having ordinary skill in the art the features discussed above regarding claims 17, 19-32, 34-38, and 55-58. Eilat seems to lack explicitly disclosing

the assigning of the first or second player to a team. Lavanchy teaches a system and method for interactive game-play over a network, and thus Eilat and Lavanchy are analogous art. Lavanchy states that if more than one match (set of teams) has the same disparity of players from one team with players from another team, the system may place a player in a match with the fewest human players. Lavanchy further states that players may be randomly assigned to matches. See column 9, lines 47-65.

Lavanchy states that an object of the invention is to provide systems and methods for creating a compelling multi-player experience as well as to foster a community of like-minded sports fans (column 1, lines 65-67). Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to modify Eilat to incorporate team assignment at least in order to allow players to create a community of like-minded players.

8. Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eilat in view of Korilis, in further view of Lavanchy.

Eilat teaches to one having ordinary skill in the art the features discussed above regarding claims 17, 19-32, 34-38, and 55-58. As established above, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate Korilis' registration feature in Eilat. Eilat in view of Korilis seems to lack explicitly disclosing the assigning of the first or second player to a team. It is clear that Eilat, Korilis, and Lavanchy are analogous art. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Eilat in view of Korilis to

incorporate team assignment at least in order to allow players to create a community of like-minded players.

***Response to Arguments***

9. Applicant's arguments filed 8/23/2010 have been fully considered but they are not persuasive.

As an initial matter, it is noted that Applicant asserts that new claims 55-59 are substantially similar to now-cancelled claims 39-43 on page 11 of the Remarks section.

Applicant's arguments are directed specifically to features of the independent claims relating to customized views of a game played on the gaming system. For instance, claim 17 now recites in pertinent part "generating video images in said video game server in response to said signal, for broadcasting a view of the game where the view of the game can be customized for the game played and for the at least two players." Applicant contends that the prior art references of record do not teach or suggest "each viewer being able to customize the broadcast view, as now provided in the independent claims" (Remarks 13). The Examiner respectfully disagrees.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that each viewer is able to *individually* customize the view) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As noted above, the claimed invention merely recites (in pertinent part) that a view of the game can be customized for the at least two players. Contrary to Applicant's argument, this does not necessarily indicate that each player has his own customized view, but rather indicates that the at least two players see a customized view. This feature is shown by Eilat in at least page 22, line 24 to page 23, line 3, which shows that the game players see a second version of the game, whereas the game viewers see a different first version of the game. In this sense, the second version of the game is interpreted to be customized for the players because it differs from the first version that is viewed by the non-players.

Irrespective of the above, it is noted that the feature that Applicant relies upon for patentability (i.e., the view of the game can be customized) is an intended use recitation. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. It is clear that Eilat is fully capable of providing different views ("versions") of the game to different viewers stationed at different televisions. This may be seen for example when a first user is a participant in a first game and a second player is a participant in a second game. In the first game, the first player views a different view from the non-participant viewers (e.g., "customized" views), and in the second game, the second player views a different view from the non-participant viewers.

Finally, the fact that a video image that is transmitted to one or more viewers "can be customized" does not necessarily indicate that the customization is provided by the central system (e.g., server). Indeed, the above feature of the claims may be interpreted to mean that the central system sends identical video images to every client device (e.g., set-top box), and the equipment at the client site is responsible for customizing the signal. This may be interpreted as rudimentary adjustment to the television set itself, such as tint, hue, and contrast changes that are "customized" by a particular viewer. A given viewer could customize the view based upon whatever criteria he wanted, including based upon the game being played.

For the reasons given above, Applicant's arguments are not persuasive. The claims fail to demonstrate patentability over the cited prior art.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and is listed on the attached Notice of References Cited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. McCulloch whose telephone number is (571) 272-2818. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. H. M./  
Examiner, Art Unit 3714  
9/21/2010

/Peter DungBa Vo/  
Supervisory Patent Examiner, Art Unit 3714